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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,920	04/12/2004	Karl Pays	05725.1347-00000	2432
Thomas L. Irving ⁷⁵⁹⁰ 02/03/2009				
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P. 1300 I Street, N.W. Washington, DC 20005-3315				
EXAMINER				
VENKAT, JYOTHSNA A				
ART UNIT		PAPER NUMBER		
1619				
MAIL DATE		DELIVERY MODE		
02/03/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,920

Applicant(s)

PAYS ET AL.

Examiner

JYOTHSNA A. VENKAT

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5, 8, 9, 12, 18, 19, 21-24, 26, 36, 40 and 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 8-9, 12, 18-19, 21-24, 26, 36, 40, and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/2/09 has been entered.

Claims 1, 2, 5, 8, 9, 12, 16, 18, 19, 21-24, 26, 36, 40, 45, 71, 73, 77, 79, 82 and 83 are currently pending in the application. Claims 71, 73, 77, 79, 82, and 83 were withdrawn from consideration as being drawn to non-elected subject matter. Claims 1, 2, 5, 8, 9, 12, 18, 19, 21-24, 26, 36, 40, and 45 are examined in the application.

Claim Rejections - 35 USC § 103

1. Claims 1, 2, 5, 8-9, 12, 18-19, 21-24, 26, 36, 40, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 3,911,105(105) and 5,866,111 ('111).

Instant application is claiming a cosmetic composition comprising:

Polystearyl acrylate

Sulfoester as the film forming polymer in a cosmetically acceptable medium

Dyestuff (claim 36).

Patent '105 teaches cosmetic make up compositions using polystearyl acrylate. This compound is the species of formula II. See the abstract, see col.1, ll 5-46, see col.2, ll 1-46, see col.3, ll 65-66, see col.4, ll 49-65 for dyestuff, see col.4 last paragraph for solvents. These solvents belong to cosmetically acceptable medium. See also col.5, ll 9-64 for various cosmetic

products. See examples and see claims 1-12 and see especially claim 5 for polystearyl acrylate. Patent '105 does not teach the film forming polymer sulfoester. However, patent '111 teaches claimed sulfoester as the film forming 'polymer and using this film former in cosmetic compositions. See the abstract, see col.3, line 37 through col.4 line 43. See col.4, line 25 for EASTMAN AQ polymers. Sulfoester is also EASTMAN AQ polymer. See col.5, ll 19-26 and see the examples. Both the compositions taught by patent are drawn to mascara compositions (cosmetic).

Accordingly it would be obvious to one skilled in the cosmetic art to prepare a third composition by combining the prior art ingredients. One of ordinary skill in the cosmetic art would combine the polystearyl acrylate and dyestuff of patent '105 and combine it with the film forming polymer since the third composition which has polystearyl acrylate when used in the form of mascara has good adherence and have sufficient brilliance and when polystearyl acrylate is combined with film forming polymer of patent '111, the composition in the form of mascara has the properties of eyelash elongation, eyelash curving which are beneficial to the consumer. Combining the prior art ingredients in the field of endeavor prompt variations of it for use in the same field of endeavor. This is a prima facie case of obviousness.

Response to Arguments

Applicant's arguments filed 1/2/09 have been fully considered but they are not persuasive.

Applicants' argue:

"Even if one of ordinary skill in the art had combined the teachings of the '105 and '111 patents, as proposed by the Examiner, and further had

modified the percentages of the at least one amorphous film-forming polymer and the first compound in order to optimize those percentages, it would not have been obvious to modify the percentages such that "the at least one amorphous film-forming polymer is present in an amount greater than or equal to the amount of the first compound," as recited in independent claim 1. Since the '105 patent does not disclose polystearyl acrylate in its Examples, Applicants refer the Examiner to Example 8 in Table A of the '105 patent. Example 8 discloses the preparation of polystearyl methacrylate, which is used in Examples 18 and 22 of the '105 patent. See the '105 patent, Table A, col. 10, lines 21-45, and col. 11, line 54 through col. 12, line 10. Also, Example 29 of the '105 patent may be modified to use polystearyl methacrylate. See *id.*, col. 14, lines 19-40. In Examples 18, 22, and 29 of the '105 patent, the compositions each have a mass of 100g, and contain 20%, 10%, and 15% polystearyl methacrylate, respectively. See *id.* The Examiner's proposed combination of the '105 and '111 patents would have to include at least one amorphous film-forming polymer in amounts greater than these percentages in order to disclose or suggest "the at least one amorphous film-forming polymer is present in an amount greater than or equal to the amount of the first compound," as recited in independent claim 1. However, the '111 patent discloses that the film-forming polymer constitutes only 1% to 8% of the compositions of the '111 patent. See the '111 patent, Table II “.

In response to the above argument, patent '105 under examples 18, 22, and 29 of the '105 patent teach 20%, 10%, and 15% polystearyl methacrylate, respectively and patent under claim 5 teaches that homopolymer can be polystearyl acrylate (elected species, belonging to first compound) . Polystearyl acrylate and polystearyl methacrylate share close structural similarity since the latter compound is the homologue of claimed species belonging to first compound. Patent '111 may teach 1-8% of the amorphous film forming polymer in the examples, however patent at col.4, ll 36-38 teaches the film forming polymer to be from 0.1 to 25%. Thus the weight percent of 20-25% for the film forming polymer in patent '111 meets the claim limitation "the at least one amorphous film-forming polymer is present in an amount greater than or equal to the amount of the first compound," as recited in independent claim 1. patent '11 is not only valid for the examples, but to the entire disclosure.

In conclusion, patent '105 teaches claimed species in mascara compositions and patent '111 teaches claimed amorphous film forming polymer in mascara compositions and one of ordinary skill in the art would prepare a third composition by combining the ingredients which have been used individually in mascara compositions. Motivation to combine the ingredients flows logically from the art. With respect to the limitation" at least one amorphous film-forming polymer is present in an amount greater than or equal to the amount of the first compound" one of ordinary skill in the art will improve upon the weight percent of film forming polymer taught by patent '111 because one of ordinary skill in the cosmetic art would discover the optimum range by routine experimentation.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art

of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619